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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,961	12/01/2000	Isao Tomon	KYO.P0005	5860

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/727,961	<b>Applicant(s)</b> Tomon	
	<b>Examiner</b> O'Connor	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on February 17, 2004 (Amdt).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, and 7 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 17, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040312</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on February 17, 2004 in reply to the previous Office action on the merits, mailed October 22, 2003.
2. The amendment of claims 1 and 2 by applicant in the reply filed February 17, 2004 is hereby acknowledged.
3. The cancellation of claims 5 and 8-14 by applicant in the reply filed February 17, 2004 is hereby acknowledged.

### ***Drawings***

4. The proposed drawing corrections and/or the proposed substitute sheets of drawings filed on February 17, 2004 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumori (US 6,179,206), in view of Fox et al. (US 5,943,624).

Matsumori discloses an IT (Information Technology) system comprising: issuing and managing means 12 for issuing and managing an RFID (Radio Frequency ID) having a unified data format; an S-label on which the issued RFID is recorded; reading means 72 for reading data including said RFID recorded on said S-label; authenticating means for authenticating said RFID read by said reading means; and, service providing means for providing various kinds of services (price check, purchase, etc.) to an owner of said S-label based on data read by said reading means when authentication by said authenticating means achieves success, wherein the S-label of the IT system of Matsumori includes: an RFID storage portion for storing said RFID; a user storage portion for storing data inherent to each S-label; and an electric wave transmission portion for transmitting data stored in said RFID storage portion and said user storage portion by wireless, but, while the S-label of Matsumori must inherently have at least one controller, Matsumori does not explicitly disclose that the S-label includes both a first controller and a second controller.

However, Fox et al. disclose a similar RFID tag/chip 42, which RFID tag/chip 42 indeed includes both a first controller 41 and a second controller 49. See, in particular, Figure 3.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the IT system of Matsumori so as to include both a first controller and a second controller on the RFID tag/chip, in accordance with the teachings of Fox et al., in order to facilitate the processing to be performed by the processing section of the chip by providing a co-processor, thereby increasing the processing capacity of the system, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 2, the IT system of Matsumori further comprises transmitting means 58 for transmitting, to said authenticating means, said RFID read by said reading means, said issuing and managing means, said transmitting means, said authenticating means, and said service providing means transmitting/receiving data to/from each other through a network.

Regarding claims 3 and 4, Matsumori does not discuss the particular type of link used between the reading means and the transmitting means, thus does not disclose that the link is by means of a USB (Universal Serial Bus) interface or an infrared link, though Matsumori does disclose the use of infrared links elsewhere in the IT system network. However, the examiner takes official notice that both USB interfaces and infrared links are well known, hence, obvious types of means of connecting peripherals to a terminal. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the IT system of

Matsumori (if necessary), so as to connect the reading means to the transmitting means by any convenient means, including either a USB interface or an infrared link, as is well known to do, merely as an expedient matter of design choice, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 6, the reading means of the IT system of Matsumori is a scanner having a card size (various types of “cards” being available in virtually any size).

Regarding claim 7, the recited functional language (“lending” the S-Label with or without charge for a predetermined period) has been deemed merely intended usage of the invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §§ 2114 and 2173.05(g).

### ***Response to Arguments***

7. Applicant’s arguments filed February 17, 2004 have been fully considered but they are not deemed persuasive.
8. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant’s amendment, and the consequent new grounds of rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

October 19, 2006

 10/19/06

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627